

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KATSUJI MURAMATSU and SHOJI IWAMOTO

Appeal No. 1998-2903
Application No. 08/607,305

ON BRIEF

Before HAIRSTON, KRASS, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2-21, 33 and 46-49. Claim 49 was canceled in an after final amendment, filed Aug. 12, 1997 and claims 15 and 48 were amended at this time. Therefore, claims 2-21, 33 and 46-48 remain on appeal.

We REVERSE.

BACKGROUND

The appellants' invention relates to a lens-fitted photographic film unit and method of manufacturing the same. An understanding of the invention can be derived from a reading of exemplary claim 46, which is reproduced below.

46. A method of manufacturing a lens-fitted photographic film unit, said lens-fitted film unit including a sprocket which is in mesh with perforations in photographic film and which is rotated by said film by a predetermined angle when said photographic film is advanced by one frame, and including a shutter mechanism which is cocked responsive to rotation of said sprocket, said photographic film unit being capable of exposing at least one additional frame on said film than the number of exposures for which said film is rated, said manufacturing method comprising:

setting said sprocket in a first rotated position in order to bring said shutter mechanism into a predetermined first at least partially cocked state;

thereafter loading said photographic film into said lens-fitted film unit while maintaining said shutter mechanism in said predetermined first state; and

testing operability of said lens-fitted photographic film unit with said photographic film installed by releasing said shutter mechanism.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Mochida et al. (Mochida) 4,954,857 Sep. 04, 1990

Claims 2-21, 33, and 46-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mochida.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 16, mailed November 3, 1997) for the examiner's reasoning in support of the rejections, and to the appellants' brief (Paper No. 14, filed August 12, 1997) and reply brief (Paper No. 17, filed January 5, 1998) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Appellants argue that "[p]ages 8-13 of the Examiner's Answer are brilliant and display very impressive legal scholarship, but they are hindsight and leave unanswered the question: If it was so simple and obvious, then why wasn't it previously done?" (See reply brief, at page 4.) We agree with appellants that those pages of the answer are presented well by the examiner, but are lacking in support in either Mochida or the examiner's explanation of the level of skill in the art. From our review of Mochida and those portions cited by the examiner, we find that Mochida does not clearly support the propositions advanced by the examiner. We find Mochida merely teaches the basic

structure and operation of a lens-fitted photographic film unit where the film is wound into the patrone frame by frame as pictures are taken by a user. (See answer at pages 4-6 and Mochida generally.) Mochida also teaches that it is desirable to test the shutter and film advancing mechanism prior to shipment. (See reply brief at pages 3-4 and Mochida at page 11.) The examiner maintains that the cited text concerning the testing is motivation to skilled artisans to at least partially cock the shutter prior to loading the film. (See answer at pages 8-13.) We disagree with the examiner and find that his rationale is based upon speculation and conjecture which is not supported by Mochida or the record before us. The examiner postulates time savings and efficiencies in the answer at pages 8 and 9, but appellants have rebutted the examiner's conclusions in the reply brief at pages 1-3. We agree with appellants that there may be other efficiencies and alternatives which the examiner does not evaluate on the record. We find that the examiner's assertions are not clearly supported by the record before us and are based upon hindsight gleaned from appellants' specification. The examiner further requires a statement of the problem in the specification and evidence of the problem, and the examiner maintains that the claimed invention is merely a change in the order of the steps. In response, appellants cite the relevant portion of the specification supporting the problem solved. (See reply brief at page 3.) Furthermore, we find it puzzling that the examiner is requiring evidence when the examiner's rejection

dances over the prior art only touching the needed words, and then expanding thereon with no support therefore, and subsequently, requires more evidence from appellants than he has set forth in his rejection.

The examiner maintains that Mochida at col. 11 "shows that the 'problem' was recognized in the prior art." (See answer at page 13.) Appellants argue that Mochida does not state a problem, but a statement of how the extra length of film was used in the prior art for blind exposures. (See reply brief at page 4.) We agree with appellants that Mochida does not clearly teach or suggest the problem solved by appellants. Appellants argue that the applied prior art does not recognize the problem of optimizing the number of frames from the set length of film, nor does it recognize the solution. (See brief at page 5.) We agree with appellants.

Appellants argue that the testing of the shutter prior to loading the film as advanced by the examiner in the final rejection does not teach the claimed sequence. (See brief at page 5.) We agree with appellants. As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). We find that the examiner has not provided a teaching or convincing line of reasoning why one skilled in the art would have desired to modify the teachings of Mochida to achieve the invention as recited in claim 46. Similarly, the examiner has not addressed

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the language of independent claim 33. Therefore, the examiner has not provided a ***prima facie*** case of obviousness with respect to claims 33 and 46. Therefore, we cannot sustain the rejection of claims 2-21, 33 and 46-48 over Mochida alone.

CONCLUSION

To summarize, the decision of the examiner to reject claims 2-21, 33 and 46-48 under 35 U.S.C. § 103(a) is reversed.

REVERSED

KENNETH W. HAIRSTON
Administrative Patent Judge

ERROL A. KRASS
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

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